

REMARKS

The Application has been reviewed in light of the Final Office Action mailed August 27, 2003. At the time of the Final Office Action, Claims 1-24 were previously cancelled by Applicants and Claims 25-43 were pending in this Application. The Examiner has rejected Claims 25-43 under 35 U.S.C. §103(a). Applicants respectfully request reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 103

Claims 25-43 were rejected by the Examiner under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,154,738 issued to Charles Gainor Call (hereafter "Call") in view of U.S. Patent Application Publication 2002/0029181 filed by Michael R. Miller et al. (hereafter "Miller"). Applicants respectfully traverse and submit that Call fails to teach or suggest the claimed invention.

First, although the Examiner has specifically addressed elements of Claim 25 in the office action, he has not specifically addressed any other claim. While it might be implied that Claims dependent upon Claim 25 do not present additional limitations that overcome the rejection of the independent claim, Applicants respectfully request that such implications be spelled out and that support be provided for the assertion that additional limitations in dependent claims do not render them patentable.

37 C.F.R. §1.104(b) requires that the Examiner's action be complete. Furthermore, 37 C.F.R. §1.104(c)(2) indicates that "[t]he pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified." Applicants assert that any application of the references cited by the Examiner to the claims dependent upon Claim 25, namely Claims 26-30 is not apparent and request that the pertinence be clearly explained as required by 37 C.F.R. §1.104(c)(2) or that the rejections be withdrawn and claims allowed.

Furthermore, the Examiner also fails to specifically address the additional independent claims in the present application and the claims dependent thereon. It is certainly not apparent how the cited references are supposed to apply to these additional independent claims, namely Claims 31, 40 and 42. Therefore, Applicants respectfully request that the Examiner provide a specific analysis for each of these claims and their dependent claims, as necessary, or allow these claims.

Turning to Claim 25, although the Examiner has specifically referenced elements of Applicants' Claim 25 in the Office Action, he has cited to very large sections of the Call

reference. Applicants therefore have had difficulty in determining where in the reference the Examiner believes the specific alleged prior art disclosures are found. Applicants draw the Examiner's attention to yet another portion of rule cited above, 37 C.F.R. §1.104(c)(2), which states, "[w]hen a reference is complex of shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable." Applicants believe that designation of multiple columns in a patent that clearly contain significant amounts of material of no relation to the present invention does not comply with the above requirement. Accordingly, Applicants request that the Examiner provide a more specific designation of the allegedly relevant portions of the Call reference, where the Examiner has not done so.

Applicants thank the Examiner for specific quotations in the instances where they have been provided. Such quotations are extremely helpful to Applicants in responding to the Examiner's rejections. Regarding the citations where the Examiner has not provided specific quotations, should the Examiner believe that large portions of the Call reference are required to show the element addressed, Applicants request that the Examiner then provide an explanation of the pertinence of these lengthy sections, as also required under 37 C.F.R. §1.104(2) and explained above.

Despite the difficulties in determining the exact nature of the Examiner's rejection, Applicants assert that the Examiner has not accurately characterized the Call reference. The reference does relate to the dissemination of product information, but it appears to focus on whole products, such as books, rather than products with removable and replaceable parts, such as the hardware claimed in Applicants' invention. Additionally, Call does not provide for modification of manufacturer's information. Additionally, Applicants have reviewed the large sections of text cited by the Examiner and believe that they generally do not contain the asserted disclosures.

First, Col. 4, line 1 - Col. 5, line 26 does contain the quoted segment of text, but this text on its face addresses only retrieval of product information from a manufacturer. This has nothing to do with the claim element for which it is cited. Specifically, the Call reference does not disclose providing any sort of hardware and certainly does not address modifying hardware from the original state as suggested in the claim element.

Second, Applicants cannot locate a portion of Col. 5, line 29 - Col. 8, line 60 that specifically recites "receiving the original hardware description" or something similar.

However, if the Examiner can provide a more specific reference or a more detailed explanation, Applicants will be more than happy to address his concerns.

Third, Applicants cannot find any mention of "modifying the hardware description to accurately describe the modified hardware" in Col. 11, line 61- Col. 14 - line 2 of the Call reference or anywhere else in the reference. This relates to Applicants' essential assertion that Call does not describe a system or method in any way similar to Applicants' invention. Applicants' invention allows retrieval of manufacturer-provided information followed by modification of that information to match modifications to hardware. Call relates to essentially a catalog of manufacturer information. It in no way teaches or suggests modifying that information to match the current or prospective modified state of a product. Each and every claim in the present application contains at least one limitation relating to such modification. Therefore, no claims are obvious in light of Call because of this deficiency, which is not remedied by any other art cited by the Examiner.

Fourth, the "inventory database" in Figure 7 does not disclose "transmitting the modified hardware description to an online auction database." As noted above, Call does not address modification of hardware descriptions at all. Furthermore, the "inventory database" of Figure 7 is part of "the retailer's inventory control system seen at 420 in Fig. 6". (See Col. 29, lines 64-66.) The "inventory database" is described further as follows: "Sales are manifested by the identification of goods and quantities purchased, and these are reflected in the actual delivery of goods at the point of sale terminal which, in turn, are posted to decrement the on-hand quantity values for products maintained in the inventory control database 500." (See Col. 31, lines 19-24.) Therefore, is clear that the "inventory database", identified by the number 500 in the drawing, actually only catalogs the number of products on-hand and has nothing to do with transmitting a description of anything to an online auction.

In summary, the Call reference simply does not teach or suggest several elements of Claim 25 and dependent claims 26-30. The Call reference also does not teach or suggest at least the modification element of all other claims. Additionally, Applicants respectfully request a more thorough analysis of Claims 26-42, and in particular independent Claims 31, 40 and 42 if the rejection of these claims is maintained, as is required by 37 C.F.R. §§1.104(b) and (c)


CONCLUSION

For the foregoing reasons, Applicants request that Claims 25-43 be allowed. Early and favorable acceptance of this application is respectfully requested.

Applicants believe no fee is due with this timely response. The Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0383 of Baker Botts L.L.P.

Respectfully submitted,

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